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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/822,903

04/13/2004

Hoseong Kim

JPL-102-B

4006

22825 7590 02/13/2008

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EXAMINER

MAI, TRI M

ART UNIT

PAPER NUMBER

3781

MAIL DATE

DELIVERY MODE

02/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/822,903	Applicant(s) KIM, HOSEONG	
	Examiner Tri M. Mai	Art Unit 3781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. Claims 8-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Applicant elected group I without traverse. .
2. Claims 1, 3, 4, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choe (6398025) in view of Harkin (D468384) or Colinelli (D403727). Choe teaches a rigid outer shell 22 (note col. 4, ln. 33) defining a center cavity, an outer soft shell 21 and means for restricting movement inside the cavity. Choe meets all claimed limitations except for the outer representing the fur of an animal. Either Harkins or Colinelli teaches that it is known in the art to provide an animal shape in a head cover. It would have been obvious to one of ordinary skill in the art to provide the outer soft shell representing the animal shape to provide aesthetic.

Regarding claim 3, Note the ribbed cylinder shape portion 50.

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Choe rejections as set forth in paragraph 2, and further in view of Austin (3501862). It would have been obvious to one of ordinary skill in the art to provide glass eyes as taught by Austin (col. 1, ln. 43) to provide the desired material for the eyes.
4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Choe rejections as set forth in paragraph 2, and further in view of Rogers (6571947) or Wolheim et al. (4667716). It would have been obvious to one of ordinary skill in the art to provide a filler material as taught by Rogers (note at portion 45 in Fig. 5) or Solheim et al. (portion 38) to provide added protection for the golf club.
5. Claims 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choe (6398025) in view Colinelli, as set forth above, and further in view of Steiner (5897027). Steiner teaches that it is known in the art to provide molded surface of an animal shape with cavities. It

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would have been obvious to one of ordinary skill in the art to mold the shape of Colinelli with cavities, especially in the eyes and mouth to provide alternative figures.

6. Claims 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Choe rejections as set forth in paragraph 3, and further in view of Austin (3501862). It would have been obvious to one of ordinary skill in the art to provide glass eyes as taught by Austin (col. 1, ln. 43) to provide the desired material for the eyes.

With respect to the position of the eyes in one of the carved cavities, it would have been obvious to one of ordinary skill in the art to provide the glass eyes in one of the cavities to provide the desired appearance for the device. These are one of the numerous configurations for the design of the animal shape. Applicant is noted that matter relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In this case, the molded animal shape with cavities along with the eyes are matter relating to ornamentation of the golf club cover and such ornamentation are taught by Colinelli. The position of the glass eyes in the cavities of the molded figure head are one of numerous configurations for the ornament.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Choe rejections as set forth in paragraph 5, and further in view of Rogers (6571947) or Wolheim et al. (4667716). It would have been obvious to one of ordinary skill in the art to provide a filler material as taught by Rogers (note at portion 45 in Fig. 5) or Solheim et al. (portion 38) to provide added protection for the golf club.

Applicant's arguments have been fully considered but they are not persuasive. The claims stand rejected as set forth above. Applicant asserts that the specification does not disclose that the outer layer is rigid. The examiner submits that the term "rigid" is broad and relatively defined. Furthermore, Choe clearly teaches "a rigid outer layer" (col. 4, ln. 32). With respect to the animal shape of Harkins or Colinelli. The examiner submits that the term "animal" is broad which include any cartoonish figures such as the shapes of the Harkins or Colinelli. The term "animal" does not require the shape to be an exact replicate of any animal. A mere resemblance would be sufficed. With respect to the contour of the inner rigid shell, as set forth above, the examiner submits that Choe teaches the rigid shell 22 along with the outer soft shell at 21. To shape portion 10 of Choe into an animal shape such as the shape of Harkins or Colinelli would have been obvious to provide esthetic and/or added attraction. Furthermore, matter relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In this case, the molded animal shape with cavities along with the eyes are matter relating to ornamentation of the golf club cover and such ornamentation are taught by Colinelli. The position of the glass eyes in the cavities of the molded figure head are one of numerous configurations for the ornament.

With respect to the rejection of Choe in view of Rogers or Solheim, as set forth above, it is noted that Fig. 3 teaches a device with a cavity at portion 3. The examiner submits that providing filler between in the cavity 3 would have been obvious to provide added protection. The filling in the cavity would assist in helping cushioning the golf club.

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571)272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tri M. Mai/

Primary Examiner, Art Unit 3781